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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,345	06/19/2006	Peter Kwok Hing Lam	P71317US0	9774

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EXAMINER	
ENG, ELIZABETH	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/583,345	LAM ET AL.	
	Examiner	Art Unit	
	ELIZABETH ENG	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/12/2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments

1. Applicant's amendment to the specification filed 4/12/2010 overcomes the informality rejections of the previous Office Action dated 2/5/2010. Responses to the Applicant's arguments are below.

35 U.S.C. 103 Rejection

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 16-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaanbengaard et al. (US Pat. No. 6,558,792) further in view of Fattman et al. (US 2005/0080155).

6. Regarding claims 16-32, Vaanbengaard et al. teaches a pressure sensitive adhesive composition comprising a rubber elastomeric base, wherein the adhesive composition consists of a homogeneous mixture of 15-60% of one or more rubbery components (claim 27), 10-60% of a mixture of hydrocolloids (claims 28 and 29), 1-50% of tackifier resin (claim 30), and 0-15% of a cohesive strengthening agent [Abstract].

7. More specifically, in example 5, Vaanbengaard prepares an adhesive material comprising polyisobutylene (PIB) as the rubbery component (claim 23), a physically cross-linked (claim 21) [column 10, claim 5] styrene-isoprene-styrene (SIS) copolymer as the cohesive strengthening agent (claims 18-20 and 22) [column 6, line 66], and a mixture of hydrocolloids consisting of amidated pectin, potato starch, and carboxymethylcellulose (CMC) [column 7, Table 3].

8. Vaanbengaard further teaches the adhesive is used for the preparation of a wound dressing or an adhesive wafer (claims 31 and 32) [column 1, line 18].

9. Vaanbengaard teaches the cohesive strengthening agent is a styrene-isoprene-styrene copolymer wherein isoprene is a linear *unsaturated* hydrocarbon. Vaanbengaard is silent with respect to the styrene copolymer containing a linear *saturated* hydrocarbon having the same chemical structure as the rubbery polyisobutylene component. However, in the same field of endeavor of producing an adhesive for use in an ostomy device, Fattman et al. teaches a styrene-isobutylene-styrene (SIBS) copolymer has good chemical resistance and hence good resistance to stomal effluent [0038].

10. Since Vaanbengaard et al. endeavors to produce adhesives that are resistant to biological fluids [abstract], it would have been obvious to one of ordinary skill in the art at the time the invention was made to produce the adhesive composition of Vaanbengaard using styrene-isobutylene-styrene copolymer (SIBS) as well as styrene-isoprene-styrene block copolymers since Fattman teaches SIBS is also resistant to stomal effluent.

11. Regarding claim 17, the combination of Vaanbengaard and Fattman would yield an adhesive containing a linear, saturated hydrocarbon having the same chemical structure as the rubbery polyisobutylene component in Vaanbengaard.

12. The combination of Vaanbengaard and Fattman is silent with respect to the molecular weights of the styrene and linear saturated hydrocarbon in the copolymer (claims 24 and 25) as well as the molecular weight of the polyisobutylene (claim 26).

However, Vaanbengaard uses the same polyisobutylene product as the instant invention [Page 15, bottom], wherein both inventions use Vistanex from Exxon Chemical Co. grade LM-MH [column 5, lines 46-47]. Fattman also uses the same styrene copolymer SIBSTAR 073T [Page 8, Table 10] as the instant invention [Page 15], wherein the copolymer has a molecular weight of 65,000 g/mol and a styrene content of 30% [Page 5, bottom of Table 4- Page 6, top of Table 4 continued]. Since both Vaanbengaard and Fatman use the same polymer products as the instant invention, there is reasonable basis to believe that the molecular weights of the styrene copolymer and the polyisobutylene of the prior arts are within the claimed ranges.

13. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaanbengaard et al. (US Pat. No. 6,558,792) in view of Fattman et al. (US 2005/0080155) as in claims 16 and 19 above, further in view of Bellingham et al. (US Pat. No. 5,109,874).

14. Regarding claims 33 and 34, Vaanbengaard teaches using an adhesive in a wound dressing [column 1, line 18] but is silent with respect to the wound dressing comprising a water-impervious backing layer or film. However, it is well known in the art for a wound dressing to containing a water-impervious film in order to protect the wound from wetness and infection. Bellingham et al. for example teaches a wound patch containing a gas and liquid impermeable member that is adhesively sealed to the skin around a wound to prevent the entering or exiting of gases and liquids through the wound, which allows the user to engage in physical activity without concern for

contaminants entering or leaving the wound area. Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Vaanbengaard and Fattman with Bellingham for the benefit of protecting wounds from contamination.

Response to Applicant's Arguments

15. Applicant's arguments filed 4/12/2010 have been fully considered but they are not persuasive for the reasons given below.

16. The Applicant argues that the Examiner has not provided a prima facie case of obviousness, wherein the Examiner has provided prior arts that teach all the elements of the invention by themselves, but does not suggest the desirability of the proposed combination of prior arts. More specifically, the Examiner discloses it would have been obvious to use the polyisobutylene-styrene block copolymer (PIBS) of Fattman in place of the styrene-isoprene-styrene (SIS) of Vaanbengaard since the migration resistance of SIBS rubber is superior to the control adhesive [0058]. However, the rejection is based on an incorrect interpretation of Fattman, wherein Fattman compares one SIBS composition to another SIBS composition but does not show the resistance of SIBS being superior to that of SIS. The superiority cited by the Examiner has nothing to do with the advantages of SIBS but rather the different compounds combined with SIBS in different formulations. Accordingly, Fattman teaches no more than that both SIS

containing adhesive and SIBS containing adhesive are known in the art and fail to show obviousness.

17. The Examiner respectfully disagrees. The fact that Fattman teaches both styrene-isoprene-styrene and styrene-isobutylene-styrene block copolymers can be used in adhesives for ostomy devices shows that it would have been obvious to one of ordinary skill in the art for Vaanbengaard to use SIBS as well as SIS. This is especially true since Fattman teaches SIBS is resistant to stomal effluent [0038] and Vaanbengaard et al. endeavors to produce an adhesive that is resistant to biological fluids [abstract]. Since SIBS exhibits a property desired by Vaanbengaard for the same use in adhesives for ostomy devices, it would have been obvious to one of ordinary skill in the art at the time the invention was made for Vaanbengaard to produce an adhesive using SIBS as well as SIS.

18. The Examiner finds the Applicant's arguments unpersuasive. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH ENG whose telephone number is (571)270-7743. The examiner can normally be reached on Mondays through Fridays from 9:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Elizabeth Eng/

/David Wu/

Supervisory Patent Examiner, Art Unit 1796